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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 05725.0993	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 10/018,769	Filed December 21, 2001
on _____ Signature _____ Typed or printed name _____		First Named Inventor Sandrine DECOSTER	
		Art Unit 1611	Examiner Gina C. Yu

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number 63,138

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

_____/Brandon B. Crisp/_____
Signature

Brandon B. Crisp
Typed or printed name

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Telephone number

October 19, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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The Examiner rejected claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu et al., WO 99/13830 ("Mitsumatsu") in view of Oshima, JP 401009916 ("Oshima") and Sebag et al., WO 98/03155 ("Sebag"). Final Office Action at 2. Applicants respectfully traverse the rejection for at least the following reasons.

Mitsumatsu does not disclose or suggest at least "[a] cosmetic composition ... wherein ... [a] C₁₈ fatty alcohol and [a] C₂₂ fatty alcohol are present in a ratio of 0.15 to 20," as recited in claim 18. Indeed, Mitsumatsu does not disclose or suggest the use of both a C₁₈ fatty alcohol and a C₂₂ fatty alcohol, and the Examiner admitted that Mitsumatsu "does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the ratio as required by instant claim 18." Id.

The Examiner relied on Oshima to allegedly overcome the deficiencies of Mitsumatsu, alleging that

[i]t would have been obvious ... to modify [the] teaching of Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima, because 1) Mitsumatsu suggests using stearyl and behenyl alcohols with the weight amount which overlaps with Oshima; and 2) Oshima teaches the combination of the two fatty alcohols in a specific ratio in a shampoo ... which is stable and imparts excellent hair conditioning effect. The skilled artisan would have had a reasonable expectation of successfully producing a stable shampoo formulation.

Id. at 3. Further, in the Advisory Action mailed September 8, 2009, the Examiner alleged that

the pending rejection properly indicated ... predictability because Oshima specifically teaches stability and effectiveness of the hair conditioning shampoo by utilizing the two fatty alcohols within the weight amount and ratio presently claimed by applicant.

Advisory Action, Continuation Sheet, page 2.

Applicants respectfully disagree with all the Examiner's allegations and submit that the Examiner has not established a *prima facie* case of obviousness. The rejection apparently relies on the rationale that "some teaching, suggestion, or motivation in the prior art ... would have led one of ordinary skill to ... combine prior art reference teachings to arrive at the claimed invention." M.P.E.P. § 2143(G). However, "[t]o reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries ... [and] must articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success;
and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Id.

That is, "[t]he rationale to support a conclusion that the claim would have been obvious is that a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." Id. (internal citations omitted, emphases added).

The Examiner has not articulated that, in the proposed combination of Mitsumatsu and Oshima, there was a reasonable expectation of success. Instead, the

Examiner alleges that on the basis of a single reference's alleged teachings -- Oshima's alleged disclosure of "a shampoo ... which is stable and imparts excellent hair conditioning effect," to which Applicants do not accede -- "[t]he skilled artisan would have had a reasonable expectation of successfully producing a stable shampoo formulation." Final Office Action at 3. As explained above, reliance on the teachings of a single reference is not sufficient to establish an expectation of success. The expectation of success must relate to the proposed combination of references.

Applicants submit that there would not have been any expectation of success for the proposed combination of Mitsumatsu and Oshima in an attempt to achieve Applicants' claimed invention. This is at least due to the unpredictability associated with the ratio of stearyl alcohol to behenyl alcohol.

"Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness." M.P.E.P. § 2143.02(II). As evidence of unpredictability, and a lack of an expectation of success, Applicants filed a Declaration under 37 C.F.R. § 1.132 on December 1, 2008. The Declaration described comparative Composition AA 904, with a ratio of stearyl alcohol to behenyl alcohol of 0.085 (outside the range recited in independent claim 18), and inventive Composition AA 905, with a ratio of 0.19 (within the range recited in claim 18). As shown in the Declaration, the viscosity of inventive Composition AA 905 was found to be less temperature dependent than the viscosity of comparative Composition AA 904. The difference in the temperature dependence of viscosity is an unpredictable result of modifying the ratio of stearyl alcohol to behenyl alcohol.

However, in the Advisory Action, the Examiner alleged that “[t]he issue here is whether it would have been obvious to incorporate Oshima’s teaching in the present invention, not whether Oshima would have predicted the properties of the applicant’s invention not explicitly covered by the prior art.” Advisory Action, Continuation Sheet, page 2. Applicants respectfully disagree.

As explained above, a rejection based on an alleged motivation to combine references also requires a reasonable expectation of success from the proposed combination. See M.P.E.P. § 2143(G). Contrary to the Examiner’s allegation, the unpredictability associated with modifying the ratio of stearyl alcohol to behenyl alcohol is indeed at issue. Because of this unpredictability, one of ordinary skill in the art could not have, from the teachings of Mitsumatsu or Oshima, or even their combination, predicted the properties of the combination proposed by the Examiner. As a consequence, one skilled in the art would not have had any expectation of success in attempting to achieve Applicants’ claimed invention, based on the proposed combination of Mitsumatsu and Oshima. For at least these reasons, one skilled in the art would not have considered combining Mitsumatsu and Oshima in an attempt to achieve Applicants’ claimed invention. Applicants’ claimed invention should be allowable over Mitsumatsu and Oshima.

Sebag is only relied upon for its alleged disclosure “that the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming composition[] having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power. See Example 1, which comprises stearyl alcohol, suggesting the compatibility of the Sebag composition with higher fatty

alcohols." Final Office Action at 3-4. The Examiner cites U.S. Patent 6,162,423 to Sebag et al. ("Sebag 2") as an English equivalent of Sebag. Id. at 3.

Applicants do not accede to this characterization of Sebag. Contrary to the Examiner's allegation, Example 1 of Sebag includes cetylstearyl alcohol and stearyl alcohol oxyethylentated with ethylene oxide. Further, no other examples in Sebag use any form of stearyl alcohol, and Sebag does not disclose the use of behenyl alcohol or a composition comprising both stearyl and behenyl alcohols. See Sebag 2, col. 17, lines 36-60.

Moreover, Sebag does not overcome the deficiencies of Mitsumatsu and Oshima. For instance, even if one of ordinary skill in the art at the time of the present invention had considered Sebag in addition to Mitsumatsu and Oshima, one skilled in the art still would not have had any reasonable expectation of success in combining Mitsumatsu and Oshima -- even with Sebag -- in an attempt to achieve Applicants' claimed invention. This is at least because, even considering Sebag, the results of modifying the ratio of stearyl alcohol to behenyl alcohol are not predictable.

For at least these reasons, independent claim 18 should be allowable over Mitsumatsu, Oshima, and Sebag. Independent claims 47, 49, and 50 differ in scope from claim 18 but recite similar limitations and should be allowable at least for reasons similar to those presented regarding claim 18. Claims 20-28, 30-46, 48, and 51 should also be allowable, at least due to their dependence from claim 18, 47, or 50. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.